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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,835	04/15/2004	Julia B. Mark	P1102.14005	8773
30615	7590	12/15/2005	EXAMINER	
BIRDWELL & JANKE, LLP 1100 SW SIXTH AVENUE SUITE 1400 PORTLAND, OR 97204			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,835	<b>Applicant(s)</b> MARK, JULIA B.	
	<b>Examiner</b> Mark T. Henderson	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED OFFICE ACTION**

**Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-45 have been canceled. Claims 47-91 have been added.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 46 recites the limitations: "the body" in line 3; and "the same size" in line 4. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 66 recites the limitation "the entire circumference" in line 5; and "the weight" in line 6. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 67 recites the limitation "the body" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Downing et al (4,500,223).

Downing et al discloses in Fig. 2 and 3, a book comprising a plurality of pages (2) having information thereon (Col. 2, lines 20-25), connected by at least two spaced apart connectors (12) to a loop (14); wherein the loop is adapted to encircle a first body portion to attach the pages to a body; wherein the pages are substantially the same size and shape as each other and have corresponding first edges, and wherein

the pages are bound together (through the loop connectors as seen in Fig. 2) at the first edges.

6. Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Young (4,395,057).

Young discloses in Fig. 2-4, and 8, a wearable book comprising a plurality of pages (34) having information thereon (Col. 1, lines 15-20), connected by at least two spaced apart connectors (30) to a loop (21, in Fig. 8); wherein the loop is adapted to encircle a first body portion to attach the pages to a body (as seen in Fig. 1); wherein the pages are substantially the same size and shape as each other and have corresponding first edges (25), and wherein the pages are bound together at the first edges.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47-53, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al.

Downing et al discloses in Fig. 2, a wearable book comprising all the elements as claimed in Claim 46, and as set forth above. However, Downing et al does not disclose wherein the information comprises text and pictures (animals, plant, fungus, astronomical object, rocker/mineral; and wherein one page has one word written in one language associated with an explanatory word in a second language.

In regards to **Claims 47-53**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the book pages, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of informative indicia.

8. Claims 54-63, and 87, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al in view of Mashimo (JP2004-001539U).

Downing et al discloses in Fig. 2, a wearable book comprising all the elements as claimed in Claim 46, and as set forth above. Downing et al also discloses wherein the connectors comprise tie tabs (23 and 25). However, Downing et al does not disclose: wherein the pages of information are resistant to water; comprise synthetic paper; comprises more than one layer of synthetic paper where at least one paper is adapted to receive inks; wherein the information comprises text and pictures (animals, plant, fungus, astronomical object, rocker/mineral; and wherein one page has one word written in one language associated with an explanatory word in a second language.

Mashimo (note, it is advisable that applicant refer to US Patent Publication 2005/0230955-A1, which is a priority document and directly related to the Japanese publication) discloses in Fig. 1, a book comprising pages resistant to water, and comprises sheet coated with a synthetic resin, and wherein the coated sheet are adapted to receive printing inks (Page 1, Col. 2, Par. 0014-0016).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Downing et al's book with a synthetic, water resistant pages as taught by Mashimo for providing a book which can not be damaged by water.

In regards to **Claims 57-63**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of

patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the book pages, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of informative indicia.

9. Claims 47 and 54-63, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Mashimo (JP2004-001539U).

Young discloses in Fig. 2, a wearable book comprising all the elements as claimed in Claim 46, and as set forth above. However, Young does not disclose wherein the information comprises text and pictures; wherein the pages of information are resistant to water; comprise synthetic paper; comprises more than one layer of synthetic paper where at least one paper is adapted to receive inks; wherein the information comprises text and pictures (animals, plant, fungus, astronomical object, rocker/mineral; and wherein one page has one word written in one language associated with an explanatory word in a second language.

Mashimo (note, it is advisable that applicant refer to US Patent Publication 2005/0230955-A1, which is a priority document and directly related to the Japanese publication) discloses in Fig. 1, a book comprising pages resistant to water, and comprises sheet coated with a



synthetic resin, and wherein the coated sheet are adapted to receive printing inks (Page 1, Col. 2, Par. 0014-0016).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Young's book with a synthetic, water resistant pages as taught by Mashimo for providing a book which can not be damaged by water.

In regards to **Claims 57-63**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the book pages, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of informative indicia.

10. Claims 88-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laubacher (5,421,616).

Laubacher discloses in Fig. 1-4, method for wearing a book comprising: connecting a book (2) to a loop (8); stretching the loop over a body portion; and wherein the book can be worn anywhere.

However, Laubacher does not disclose; wherein the book is waterproof and can be used underwater; an is used in a view and compare manner.

Lang discloses in Fig. 1-4, a book that is substantially waterproof and can be used underwater; wherein the book can be used in a view and compare manner (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laubacher's book with a book that has water resistant material as taught by Lang for the purpose of using the book underwater when diving.

***Allowable Subject Matter***

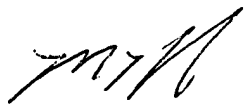
11. Claims 64-66 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leff, Ramsey III, Ross Jr., Jackson, Wolski, Hazel, Stewart Jr, Wu, Dyck, Deusch and Wilson disclose similar books.

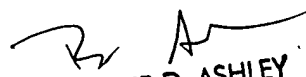
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

December 9, 2005

  
BOYER D. ASHLEY  
PRIMARY EXAMINER